

REMARKS

Applicant has carefully reviewed the Final Office Action mailed September 21, 2007, prior to preparing this response. Currently claims 3-18 are pending in the application, wherein claims 3-18 have been rejected. Claims 3 and 10 have been amended, claims 19-20 have been added, and claim 12 has been cancelled with this paper. Support for these amendments may be found, for example, at page 3, line 15 through page 4, line 3 of the Specification and FIGS. 2 and 3. No new matter has been added with these amendments. Favorable consideration of the above amendments and following remarks is respectfully requested.

Claims 3, 7-12 and 15-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hunter et al., U.S. Patent No. 6,071,030, in view of Truc et al., U.S. Patent No. 4,911,777. Applicant respectfully traverses this rejection.

In responding to the Applicant's previous remarks, the Examiner stated "although the drawings of Truc do not identify the hinge strip and the connecting strips as separate elements, it is clear from Fig. 6 that the edge strip that corresponds to the mounting strip of the current application is not directly in contact with the sheet, 12, but is connected to connecting strips that are then in contact with the sheet past the gap, 50."

Claim 3 has been amended to recite that the hinge strip includes a mounting strip and first and second connecting strips formed of a dissimilar material from the mounting strip. Each of the connecting strips is attached to the mounting strip and the blank sheet, such that each of the connecting strips spans the gap between the mounting strip and the blank sheet.

By providing the connecting strips of a dissimilar material from the material of the mounting strip, the physical characteristics of each component of the hinge strip can be individually tailored to achieve its desired function. For instance, the mounting strip may be formed of a more sturdy material such that the mounting strip resists tearing, while the connecting strips (along where the blank sheet folds relative to the mounting strip) may be formed of a more flexible material such that one may easily turn pages of a bound album without bending the blank sheets.

Therefore, a *prima facie* case of obviousness has not been established with the cited prior art at least because the cited prior art does not teach each and every limitation of claim 3. Withdrawal of the rejection is respectfully requested.

For at least the reasons stated above, claims 7-9, which depend from claim 3 and include additional limitations, are also believed to be in condition for allowance. Withdrawal of the rejection is respectfully requested.

Claim 10 has been amended to recite that the connecting strips connecting the hinge strip to the blank sheet are formed of a flexible polymeric film, and that the mounting portion of the hinge strip includes a plurality of mounting holes for mounting the hinge strip to an album.

The cited prior art does not seem to teach mounting strips formed of a flexible polymeric film which connect a hinge strip to a blank sheet as currently claimed. The connecting strips may be formed of a flexible polymeric film such that one may easily turn pages of a bound album without bending the blank sheets by folding the blank sheet relative to the mounting portion of the hinge strip along the gap over which the connecting strips are placed.

Therefore, a *prima facie* case of obviousness has not been established with the cited prior art at least because the cited prior art does not teach each and every limitation of claim 10. Withdrawal of the rejection is respectfully requested.

For at least the reasons stated above, claims 11 and 15-18, which depend from claim 10 and include additional limitations, are also believed to be in condition for allowance. Withdrawal of the rejection is respectfully requested.

Each of claims 17 and 18 recite that the blank sheets of independent claims 3 and 10 are of photo-grade material. In the Office Action, at page 6, it was asserted, that:

the term "photo-grade paper", as broadly recited, does not define a cut-off point as to what quality of photo is enough to meet this limitation. There is no indication in applicant's claim that the characteristics of the paper used are in fact limited in any way beyond that a photo can be printed on them.

Applicant respectfully disagrees. Applicant has previously submitted an affidavit and evidence that the International Standards Organization has identified a definition for the

phrase “photo-grade.” (See §1.132 Affidavit submitted on August 9, 2006). As such, the term “photo-grade” is a term of art which is known, understood and used by those of skill in the art. The submitted Affidavit declares that:

ISO 18055-1 defines photo-grade medium as a paper or film with an image receiving layer that, when printed on, can produce image quality comparable with conventional photography, in terms of resolution, graininess, sharpness, tone reproduction and colour reproduction. The standard also states that a photo-grade medium has physical characteristics comparable with conventional photographic media including stiffness, mass, texture and durability, and is generally intended for inkjet printing of photographic images in high quality and demanding applications.

Thus, the term “photo-grade” should be interpreted to mean that the sheet is of a quality that, when printed on, produces a photographic image comparable to a conventional photograph, and not simply that a photo can be printed on it.

The court has provided guidance of claim interpretation during the examination process. In *In re Zletz*, the Court stated, “[w]hen the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant’s invention and its relation to the prior art.” *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). In view of the submitted Affidavit, the term “photo-grade” was given a precise meaning consistent with how the term is used within the relevant art.

The Examiner is precluded from giving claim limitations an unreasonable interpretation when the broader definition is expressly disclaimed in the prosecution history. See *In re Bigio*, 381 F.3d 1320, 1325, 72 USPQ2d 1209, 1211 (Fed. Cir. 2004). As evidenced by the Affidavit submitted on August 9, 2006, the Applicant distinguished the claim limitation photo-grade material from any of the types and grades of paper disclosed in Hunter. Thus, the Applicant expressly disclaimed an interpretation of the claim limitation in which the claimed “photo-grade” would include any of the types and grades of paper disclosed in Hunter.

Furthermore, the Applicant respectfully disagrees with the statement in the Office Action that “the term photo-grade paper as broadly recited, does not define a cut-off requirement as to what quality of photo is enough to meet this limitation.” Applicant would

like to note that during examination, “[t]he patentee is not required to show that some technological discontinuity exists between the claimed invention and the subject matter just outside the claims, but only that the claimed subject matter would have been nonobvious in view of the prior art.” *Andrew Corp. v. Gabriel Electronics, Inc.*, 847 F.2d 819, 823, 6 USPQ2d 2010, 2014 (Fed. Cir. 1988). As declared in the Affidavit submitted on August 9, 2006, in order for a sheet to be considered of “photo-grade”, the quality of the sheet must meet or exceed ISO 18055-1. Thus, ISO 18055-1 provides a threshold level of quality which must be attained in order for a medium to be indicated as “photo-grade”. As asserted in the Affidavit, the physical characteristics of each of the various types of paper disclosed in Hunter fall below the threshold level necessary to attain “photo-grade” status, and thus outside the boundaries of the claim limitation. Therefore, in view of the submitted evidence, Hunter does not teach paper of “photo-grade” quality.

Claims 4, 6, 13 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hunter et al., U.S. Patent No. 6,071,030, in view of Truc et al., U.S. Patent No. 4,911,777, and further in view of Tyler, U.S. Patent No. 4,207,366. Applicant respectfully traverses this rejection. The Tyler reference is relied upon only to provide particulars of the type of paper used. Applicant believes that the above remarks indicate that the Hunter et al. reference cannot be appropriately modified in view of other references to render the current claims unpatentable. Therefore it is believed that a *prima facie* case of unpatentability does not exist, and the rejection of claims 4, 6, 13 and 14 has been overcome.

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Hunter et al., U.S. Patent No. 6,071,030, in view of Truc et al., U.S. Patent No. 4,911,777, and further in view of Singh, U.S. Patent No. 6,332,953. Applicant respectfully traverses this rejection. As already indicated, it is believed that the rejection of claim 3 under 35 U.S.C. §103(a) that relies the teachings of Hunter et al. and Truc et al. has been overcome. Therefore it is believed that the rejection of claim 5, which depends from claim 3 and includes additional limitations, is also overcome.

Newly added claim 19 recites a method of providing a ready-to-bind photo sheet. The method includes adhesively attaching a connecting strip formed of a flexible polymeric film along a first side of a blank sheet, and adhesively attaching the connecting strip to a mounting

strip, such that the connecting strip spans a gap between the mounting strip and the blank sheet. The cited prior art does not seem to teach this method. For at least this reason, newly presented claims 19 and 20 are believed to be patentable over the prior art of record.

Reexamination and reconsideration are respectfully requested. It is submitted that all pending claims are currently in condition for allowance. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at 612.677.9050.

Respectfully submitted,

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By his attorney,

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